

Appln No. 09/575,195
Amdt. Dated June 20, 2005
Response to Office action of April 6, 2005

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REMARKS/ARGUMENTS

The Applicant thanks the Examiner for the Office Action dated April 6, 2005.

AMENDMENTS

The term "sensing device" in the claims has been replaced with the term "optically imaging pen". Basis for this amendment can be found on page 11, line 26 of the specification.

The "interacting step" in the independent claims has been clarified by including the subject-matter previously specified in the "receiving" step.

The "printing" step in the independent claims now specifies "downloading and printing" from a "networked computer system".

CLAIM REJECTIONS - 35 USC § 112

1. Enablement Requirement

The Applicant maintains that the claimed subject-matter fully complies with the enablement requirement.

In his most recent Office Action, the Examiner states the following:

Claims 1, 4, 5, 29, 32, 33 and 49 are dedicated to online purchasing using a "sensing device". Specifically the claims recite interactions between a form and a pen. However, the Applicant's Disclosure is silent regarding the use of any other sensing device other than said pen when a customer desires to order goods and services online.

The Applicant has been unable to understand precisely what is the Examiner's objection here. If the objection is that the claims recite "sensing device" whereas the description refers to a pen, the claims have now been amended by specifying an "optically imaging pen" throughout. Explicit basis for this term can be found on page 11, line 26 of the description.

If, however, the Examiner was objecting to something else, then he is kindly requested to explain his objection in more detail. As the Examiner can see, the Applicant is willing to make amendments to the claims in order to meet the Examiner's objections under 35 USC § 112. However, it is not clear to the Applicant where the Examiner believes the claims are lacking.

2. Clarity

Claims 1, 4, 5, 29, 32, 33 and 49 specify a method of "purchasing via an interactive form". The claims do not 'teach' an online purchasing system; the claims define the invention, which is a method of enabling purchasing via a printed form.

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Taking the Examiner's analogy with known internet-based purchasing methods, the purchaser typically downloads a form onto his/her screen using a networked computer system. The purchaser then fills in the form using a mouse and keyboard, filling in checkboxes, address fields, payment methods *etc.* This step of filling in the form may be performed offline; it is only when the purchaser clicks on 'SEND' (or similar) that the information is uploaded into the networked computer system. Even when 'SEND' is clicked, the purchaser's computer can store the form and send the relevant information when the computer is re-connected to the network. This is the normal way in which 'online' purchasing works – parts of the process can be performed offline.

The Applicant's disclosure merely describes a paper-based analogous situation. Every time a purchaser interacts with a form (*e.g.* ticking a checkbox), this information does not have to be simultaneously uploaded into the networked computer system. In this sense, the purchaser is working 'offline'. Instead, the 'indicating data' generated by the pen is stored temporarily in the pen and is typically transmitted to the computer system when the purchaser clicks on 'SEND' (or similar).

The Applicant does not regard it as relevant whether or not the purchaser can be 'online' or 'offline' at any given point in the purchasing transaction. During normal internet purchasing a purchaser may be online or offline at any given time – indeed, the purchaser may not even know if he is offline or online if his computer automatically logs offline after a predetermined time period. Regardless, the purchaser does not particularly need to know, so long as his computer logs back online when a 'SEND' button is clicked.

Likewise, during netpage purchasing, a purchaser may be online or offline at any given time. In either case (internet or netpage), it is clear what 'online' purchasing involves – clearly the purchaser needs to be online at some point in order to transmit purchasing information, but the purchaser need not be online all the time.

3. Essential Steps

The independent method claims specify a downloading step, a printing step and an interacting step. The claims also specify that the computer is a networked computer system. The claims also specify that the networked computer system records form identities and a map of each form printed (*i.e.* the forms are generated by a special server specifically adapted for netpage applications).

The Applicant has addressed all the Examiner's objections regarding omission of essential steps by amendment to the claims. If the Examiner believes that further amendments are required, he is requested to provide specific details of what amendments he believes to be necessary.

CLAIM REJECTIONS - 35 USC § 102 & 103

The Applicant maintains that claim 1 is clearly not anticipated by Buckley *et al.* (US 6,446,871).

As the Applicant has already explained during the prosecution of this case, the presently claimed method and system relies on netpage forms containing **map references**. The map references on a form are used by a pen to determine its position relative to the form. A computer system receives this position information from the pen. The computer system also

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receives information on the identity of the form from the pen. With this information, the computer system identifies the requested purchasing transaction by looking up the pen's position on a map of the form recorded in the computer system.

The present information relies on the pen determining its position, using coordinate information embedded in coded data on the form.

By contrast, Buckley says nothing about a pen determining its position on a form and a computer system identifying a request by comparing the pen's position with a map of the form.

The Examiner has referred to Figures 1, 4, 5 and 7-9 in Buckley. These Figures show nothing more than a barcode as a means for uploading information into a computer system. The Figures say nothing about what information is contained in the barcode or how this information is used by the computer system. However, it is clear from the description of Buckley (column 4, line 49 *et seq.*) that the barcodes do not contain information that would allow the pen to determine its position. It also clear that the computer system does not record a map of each page that is used in conjunction with positional information provided by the pen.

The Applicant submits that Buckley fails to disclose the following features specified in the present claims:

- (a) coded data indicative of a plurality of map references on the form;
- (b) a map of the locations stored in a computer system;
- (c) a pen generating data regarding its position relative to the form.

The Examiner is invited to explain where these features can be found in Buckley. The Applicant submits that the Examiner's objection under 35 USC § 102 is not sustainable until the Examiner identifies specific passages of Buckley disclosing these features in the Applicant's claims. Vague references to Figures 1, 4, 5 and 7-9 in Buckley are not considered by the Applicant to be supportive of the Examiner maintaining his objection of lack of novelty and/or obviousness.

As regards the Examiner's objections of obviousness, the additional references cited appear to have been introduced solely for the purposes of attacking the dependent claims. The Applicant maintains that none of the cited prior art teaches or suggests a method or system whereby a sensing devices senses its **position** on a form and transmits this information to a computer system, which has a map of the form recorded in it. Accordingly, it is submitted that claim 1 and all claims dependent thereon are not obvious in view of the cited prior art.

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It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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